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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/476,877 01/03/00 AUGUBEL

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STANLEY B GREEN  
MORGAN & FINNEGAN LLP  
345 PARK AVENUE  
NEW YORK NY 10154

LM02/0608

EXAMINER

POINVIL, F

ART UNIT

PAPER NUMBER

2768

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DATE MAILED:

06/08/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/476,877**

Applicant

**AUSUBEL**

Examiner  
**Frantzy Poinvil**

Group Art Unit  
**2768**



☒ Responsive to communication(s) filed on Jan 3, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-20 and 53-86 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20, 53, 54, 57, 60, 61, 64-68, 71-75, and 78-86 is/are rejected.

☒ Claim(s) 55, 56, 58, 59, 62, 63, 69, 70, 76, and 77 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-20 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 respectively of prior U.S. Patent No. 5,905,975. This is a double patenting rejection.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 53-54, 57, 60-61, 64-68, 71-75 and 78-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Business Editors (hereinafter, ONSALE).

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As per claim 53, ONSALE discloses an auction system comprising an auctioneer system coupling to at least two remote user systems. The user system is a general purpose computer comprising means for receiving messages from the auctioneer's system and for displaying messages; means for receiving bid related information from users; means for transmitting bid information to the auctioneer's system. See the entire document.

The auctioneer's system including means for generating and transmitting messages to user systems, means for receiving bid information from user systems and decision means responsive to the bid information for determining whether an auction should continue or terminate. The decision means including means for initiating a non-final message to continue the auction and a final message to terminate the auction. See the entire document. The only difference between the ONSALE system is that the auction as claimed is to television licenses and/or associated derivative rights. These kinds of data do not affect the functionality of the system of ONSALE as these are merely different types of data that cannot be accorded patentable differences. These are different intended types of "items", "things" or "objects" that would have been obvious to the skilled artisan when gleaning from the ONSALE system.

Claim 54 is directed the different parameters associated in most types of auctions. They include a value such as quantity or monetary value and a type of data (such as license subset identification). These types of data that do not affect the functioning of the ONSALE system since in memory, or computer manipulation, data is only data.

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As per claim 57, auctions are well known to be conducted in multiple rounds. Doing the same in the ONSALE system would have been obvious to the skilled artisan in order to simulate a live auction.

Claims 60-61 contain limitations addressed in respective claims 53-54 and therefore are rejected under a similar rationale.

As per claims 64-65, note the rejection of claim 57 above.

As per claim 66, these limitations would have been obvious to the skilled artisan when viewing the system of ONSALE in order to determine the total of items being bid on.

As per claims 67 and 68, applicant is directed to the rejection of claims 53 and 54 respectively.

As per claims 71-72, note the rejection of claim 57 above.

As per claim 73, these limitations would have been obvious to the skilled artisan when viewing the system of ONSALE in order to determine the total of items being bid on.

As pr claims 74-75, note the respective rejections of claims 53 and 54 above.

As per claims 78-79, note the rejection of claim 57 above.

As per claim 80, these limitations would have been obvious to the skilled artisan when viewing the system of ONSALE in order to determine the total of items being bid on.

As per claims 81-83, applicant is directed to the rejection of respective claims 53, 57 and 54.

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As per claims 84-86, applicant is directed to the rejection of respective claims 53, 57 and 54.

5. Claims 55-56, 58-59, 62-63, 69-70 and 76-77 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6.

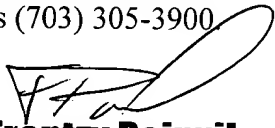
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil, whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

The fax phone number for this Art Unit is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.  
FP

03Jun00



**Frantzy Poinvil**  
**Primary Examiner**  
**Art Unit 2768**